

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENNING VON SPRECKELSEN and PETER M. MCGEOUGH

Appeal No. 2004-1243
Application No. 09/701,057

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) for appropriate action with regard to the following issues.

(1) In the final rejection (Paper No. 9) the examiner rejected claims 11-15 under 35 U.S.C. § 103, with claim 11 being rejected as unpatentable over Gach¹ in view of

¹ U.S. Pat. No. 4,815,618.

Graboski.² An amendment after final (Paper No. 10) was subsequently filed cancelling claim 11 and re-writing it as claim 16 and amending claim 12. The examiner indicated in an advisory action (Paper No. 11) that said amendment would be entered for purposes of appeal, with claim 16 being rejected as unpatentable over Gach in view of Graboski as applied to claim 11. Further, the examiner's agreement on page 2 of the answer (Paper No. 15) with the appellants' statement of the status of amendments and with the copy of the appealed claims in the appendix to appellants' brief (Paper No. 14) confirms that the amendment after final was entered. In stating the rejections, however, the answer repeats the rejection of claim 11 from the final rejection and does not treat claim 16, thereby raising a question as to whether the examiner in fact considered the amendment after final in preparing the answer.

We additionally note that the examiner's rejection of claim 11, based on Gach in view of Graboski, does not appear to address the limitation in now canceled claim 11 and contained in new claim 16 that the neck assembly and cap are injection molded. This is in contrast to the examiner's rejection of claim 12 wherein the examiner relied on Flanagan³ in combination with Gach and Graboski, for a suggestion to make the neck

² U.S. Pat. No. 6,117,506.

³ U.S. Pat. No. 6,082,568.

and cap on Gach's dispenser by injection molding. It is thus not clear whether the examiner appreciated that claim 16, like claim 12,⁴ contains such a limitation.

In light of the above, we remand this application to the examiner to clarify the claims rejected and, in particular, the status of claim 16, and to give the examiner the opportunity to review the scope of claim 16 to assess whether the combination of Gach and Graboski is sufficient to suggest the subject matter thereof.

(2) While a patent to Nolan⁵ referred to on page 5 of the answer is not relied upon by the examiner in rejecting any of the claims on appeal, we do note that the appellants have challenged the examiner's discussion of the teachings of Nolan on pages 2-3 of the reply brief (Paper No. 16) and the examiner has not responded to this challenge. Thus, under this remand, the examiner is given the opportunity to clarify the significance of the examiner's reference to Nolan in the answer (i.e., to decide whether a new ground of rejection of any of the claims based on Nolan would be appropriate) and to respond, if necessary, to the appellants' remarks with respect to Nolan in the reply brief.

(3) The examiner has not indicated on the record whether Exhibit I appended to the reply brief has been considered by the examiner. Thus, under this remand, the

⁴ We recognize that claim 16 is directed to an assembly, while claim 12 is directed to a process, thereby perhaps justifying different treatment of the injection molding limitations in each of these claims, but also note that the answer does not treat this limitation in claim 16 (or 11) at all.


⁵ U.S. Pat. No. 4,722,448.

examiner is required to indicate, on the record, whether Exhibit I has been considered as evidence and, if it is considered, to weigh it along with the other evidence of record in this case.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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